

REMARKS

The applicants respectfully requests reconsideration of the above referenced patent application in view of the amendments and remarks set forth herein, and respectfully request that the Examiner withdraw all rejections. Claims 1, 8 and 14 have been amended. No claims have been canceled. No claims have been added. Thus, claims 1-6, 8-12 and 14-18 are pending.

35 U.S.C. §103 Rejections

35 U.S.C. §103(a) Rejection over *Fortin* and *Douglis*

The Office Action rejects claims 1, 2, 6, 8, 9, 14 and 15 under §103(a) as being unpatentable over Fortin et al., US PG Publication 2004/0003223 A1 (*Fortin*) in view of Douglis et al., USPN 5,481,733 (*Douglis*). Specifically, the Office Action alleges that *Fortin* discloses use of various forms of non-volatile memory to save configuration data when a hard drive is spun down. *Douglis* is alleged to suggest the substitution of performance data for the configuration data of *Fortin*, so as to render the present invention obvious. A *prima facie* case for obviousness under 35 U.S.C. §103(a) requires, *inter alia*, a showing that all of the elements are taught or suggested by some combination of the cited references, and a showing of a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See M.P.E.P. §2143. For at least the following reasons, Applicant traverses the rejection.

Currently amended independent claim 1 recites in a salient portion (emphasis added):

“...storing historical performance data of the hard disk on a non-volatile memory unit of a system, the data including data **identifying the predetermined event as a cause of a spin-down** of the hard disk and...”

Similar limitations are included by amendment to each of independent claims 8 and 14, which each disclose storing on a non-volatile memory unit data identifying the predetermined event as a **cause** of a spin-down of a hard disk. These amendments are supported in the original disclosure at least by paragraph [0016] of the specification, which discloses recording in a non-volatile memory unit data **related to** the spinning down and up of a hard disk.

Applicants submit that the rejected claims are non-obvious at least based on the limitations of independent claims 1, 8 and 14. Specifically, neither *Douglis* nor *Fortin* discloses storing on a non-volatile memory unit data identifying the predetermined event as a **cause** of a spin-down of a hard disk, as disclosed in each of the currently amended independent claims.

Douglis is alleged in the Office Action to teach storing data which identifies an event, wherein that event is the cause of spinning-down the hard disk. However, Applicants respectfully submit that where hard disk activity is the cause of a hard disk spin down, the storing of said hard disk **activity**, in and of itself, does **not identify** the **cause** of a hard disk spin down. By way of illustration, *Douglis* requires the storing of a

larger amount of data- i.e. a history of activity of a hard disk- and an analysis of said history to derive the cause of the hard disk spin-down. Therefore, *Douglis* does not disclose storing on a non-volatile memory unit data identifying the predetermined event as a **cause** of a spin-down of a hard disk. The Office Action does not offer *Fortin* as disclosing this limitation, nor does *Fortin* teach or suggest this limitation in any way.

Assuming *arguendo* that *Douglis* and *Fortin* teach every limitation of the rejected claims, the Office Action fails to show a suggestion or motivation to modify the reference or to combine reference teachings. In proposing such a motivation, the Office Action asserts that *Fortin* would benefit by conserving power of his computer system as taught by *Douglis*. However, Applicants respectfully submit that the Office Action merely offers a reference's benefit as its own motivation to be combined, regardless of the reference with which it is to be combined.

A general allegation that one invention could also be extended to practice another invention does not in itself show how either the references themselves or the knowledge generally available to one of ordinary skill in the art provide a suggestion or motivation to modify the reference or to combine reference teachings. Otherwise, the motivation to combine requirement for obviousness under 35 U.S.C. §103 is satisfied once a reference is found to have some articulable benefit. Applicants submit that this is not the standard required in presenting a *prima facie* case for obviousness.

For at least the foregoing reasons, each of currently amended independent claims 1, 8 and 14 include at least one limitation which is not taught or suggested by any

combination of *Douglis* and *Fortin*. In depending directly or indirectly from one of independent claims 1, 8 and 14, each of dependent claims 2, 6, 9 and 15 incorporate at least one limitation not taught or suggested by the references. Accordingly, the claims are patentable and Applicants request that the rejection of claims 1, 2, 6, 8, 9, 14 and 15 under §103(a) based on *Douglis* and *Fortin* be withdrawn.

35 U.S.C. §103(a) Rejection over Fortin, Douglis and Sanada

The Office Action rejects claims 5, 12 and 18 under §103(a) as being upatentable over *Fortin* and *Douglis* in view of *Sanada et al.*, US PG Publication 2001/0002173 A1 (*Sanada*). The Office Action relies on the previous rejection of claims 1, 8 and 14, and further offers *Sanada* as disclosing the use of thin film electronic memory as a type of non-volatile memory. For the following reasons, Applicant traverses the rejection.

As discussed previously, each of currently amended independent claims 1, 8 and 14 include at least one limitation- i.e. storing on a non-volatile memory unit data identifying the predetermined event as a **cause** of a spin-down of a hard disk- which is not taught or suggested by any combination of *Douglis* and *Fortin*. The Office Action does not offer *Sanada* as disclosing said at least one limitation, nor does *Sanada* teach said at least one limitation in any way. Therefore, in depending from one of independent claims 1, 8 and 14, each of dependent claims 5, 12 and 18 incorporate at least one limitation not taught or suggested by any combination of *Fortin*, *Douglis* and *Sanada*. Accordingly, Applicants request that the rejection of claims 5, 12 and 18 under §103(a) based on *Fortin*, *Douglis* and *Sanada* be withdrawn.

35 U.S.C. §103(a) Rejection over *Fortin*, *Douglis* and *Chou*

The Office Action rejects claims 3-4, 10-11 and 16-17 under §103(a) as being unpatentable over *Fortin* and *Douglis* in view of *Chou* et al., US PG Publication 2005/0055481 A1 (*Chou*). The Office Action relies on the previous rejection of claims 1, 8 and 14, and further offers *Chou* as disclosing the use of MPCIE technology as a type of non-volatile memory. For the following reasons, Applicant traverses the rejection.

As discussed previously, each of currently amended independent claims 1, 8 and 14 include at least one limitation- i.e. storing on a non-volatile memory unit data identifying the predetermined event as a **cause** of a spin-down of a hard disk- which is not taught or suggested by any combination of *Douglis* and *Fortin*. The Office Action does not offer *Chou* as disclosing said at least one limitation, nor does *Chou* teach said at least one limitation in any way. Therefore, in depending from one of independent claims 1, 8 and 14, each of dependent claims 3-4, 10-11 and 16-17 incorporate at least one limitation not taught or suggested by any combination of *Fortin*, *Douglis* and *Chou*. Accordingly, Applicants request that the rejection of claims 3-4, 10-11 and 16-17 under §103(a) based on *Fortin*, *Douglis* and *Chou* be withdrawn.

CONCLUSION

For at least the foregoing reasons, Applicants submit that the objections and rejections have been overcome. Therefore, claims 1-6, 8-12 and 14-18 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application. Please charge any shortages and credit any overcharges to our Deposit Account No. 02-2666.

Respectfully submitted,
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